



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,204	10/14/2003	Sugato Bagchi	POU920030195US1	4088

7590 02/01/2008
William A. Kinnaman, Jr.
IBM Corporation - MS P386
2455 South Road
Poughkeepsie, NY 12601

EXAMINER

KARDOS, NEIL R

ART UNIT	PAPER NUMBER
----------	--------------

3623

MAIL DATE	DELIVERY MODE
-----------	---------------

02/01/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/685,204	Applicant(s) BAGCHI ET AL.	
	Examiner Neil R. Kardos	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) ☒ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413) |
| 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) ☐ Information Disclosure Statement(s) (PTO/SB/08) | 5) ☐ Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) ☐ Other: _____ |

DETAILED ACTION

1. This is a non-final first Office action on the merits. Currently, claims 1-19 are pending.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 8-12 recite a “system” comprising the following components: (1) an “estimator” for determining costs and savings, (2) an “estimator” for determining value, (3) a "builder" for determining benefit, and (4) a "planner" for determining resource requirements and performance metrics.

These components do not necessarily make up a physical structure. Rather, they merely constitute procedures that do not require an accompanying structure. Such procedures, in a reasonably broad sense, are merely a collection of steps to be followed in order to achieve a desired outcome (i.e. a collection of computer instructions). In a reasonably broad sense, claims 8-12 are directed to computer instructions that lack any tangible structure. Applicant's specification is directed to software that performs these procedures. However, claims 8-12 do not tangibly embody this software on a computer-readable medium. None of these claims recite any physical structure that would serve to constitute a “system.”

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. pre-grant publication number 2003/0158800 to Pisello et al ("Pisello") in view of Official Notice.

As per claims 1, 8, and 13, Pisello discloses generating a business case relative to a baseline, comprising the steps of:

- determining an investment cost (see paragraphs 33 and 36);
- determining an incremental savings in operating costs relative to said baseline (see paragraphs 38-39; paragraph 40: lines 4-9, disclosing determining cost reductions over a period of years; paragraph 91: lines 12-15, disclosing comparing costs and benefits of the project to a base case);
- determining an incremental business value to a supported business operation relative to said baseline (see paragraphs 41 and 44, disclosing measuring improvement in key performance indicators; paragraph 44: lines 7-16, disclosing determining KPI values over a period of years; paragraph 91: lines 12-15, disclosing comparing costs and benefits of the project to a base case); and
- determining whether the total benefit represented by said incremental savings in operating costs and said incremental business value justifies said investment cost (see paragraph 49, disclosing evaluating costs and benefits; paragraph 56,

disclosing determining risk; paragraph 91, disclosing comparing costs and benefits to a base case).

Pisello does not explicitly disclose wherein the business case is for an alternative server infrastructure scenario. Pisello does, however, teach using the method to evaluate potential information technology projects (see generally title, abstract, disclosure). Furthermore, Pisello teaches using the method to evaluate potential server projects (see paragraph 31: lines 6-10; paragraph 33: lines 5-7; paragraph 39: lines 1-4; paragraphs 106 and 109).

Pisello does not explicitly disclose evaluating server infrastructure, such as a grid-based infrastructure. Examiner takes Official Notice that it would have been obvious to one of ordinary skill in the information technology evaluation arts to use the evaluation methods taught by Pisello to evaluate the potential impact of a server infrastructure project. One of ordinary skill in the art would have been motivated to do so in order to realize the organizational and financial impact of making changes to their server infrastructure.

As per claims 2, 9, and 14, Pisello discloses determining resource requirements, said investment cost and said incremental savings in operating costs being determined from said resource requirements (see paragraph 33, disclosing determining resources related to investment costs such as software, network components, peripherals, and labor; paragraph 39, disclosing the same for cost savings) .

Pisello does not explicitly disclose wherein resource requirement are determined for an alternative server infrastructure. Refer to the obviousness rejection of claim 1, above.

As per claims 3, 10, 11, and 15, Pisello discloses determining performance metrics, said incremental business value being determined from said performance metrics (see paragraph 41,

disclosing wherein key performance indicators form a basis for business values such as customer satisfaction, responsiveness, innovation, etc).

Pisello does not explicitly disclose wherein performance metrics are determined for an alternative server infrastructure. Refer to the obviousness rejection of claim 1, above.

As per claims 4 and 16, Pisello discloses wherein said steps are performed for a plurality of scenarios (see paragraph 91, disclosing performing the method on a plurality of projects).

Pisello does not explicitly disclose wherein the scenarios are alternative server infrastructure scenarios. Refer to the obviousness rejection of claim 1, above.

As per claims 5 and 17, Pisello does not explicitly disclose wherein said alternative server infrastructure scenario is a grid-based scenario.

As discussed above in regards to claim 1, Pisello teaches using the method to evaluate potential server projects. Pisello does not explicitly disclose evaluating server infrastructure, such as a grid-based infrastructure. Examiner takes Official Notice that it would have been obvious to one of ordinary skill in the information technology evaluation arts to use the evaluation methods taught by Pisello to evaluate the potential impact of a grid-based server infrastructure project. One of ordinary skill in the art would have been motivated to do so in order to realize the organizational and financial impact of using a grid-based server infrastructure.

As per claims 6 and 18, Pisello discloses wherein said investment cost is an incremental investment cost of said scenario relative to said baseline scenario (see paragraph 34: lines 5-11, disclosing determining cost reductions over a period of years; paragraph 91, disclosing comparing costs and benefits to a base case).

Pisello does not explicitly disclose wherein the scenarios are alternative server infrastructure scenarios. Refer to the obviousness rejection of claim 1, above.

As per claims 7, 12, and 19, Pisello discloses wherein said step of determining whether said total benefit justifies said investment cost comprises the step of calculating a rate of return of said total benefit on said investment cost (see paragraph 56: lines 7-9, disclosing using return on investment and internal rate of return).

Additional Prior Art

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- U.S. pre-grant publication number 2005/0043977 to Ahern et al, directed to managing and tracking changes in enterprise architectures.
- U.S. pre-grant publication number 2004/0083153 to Larsen et al, directed to evaluating internal business investments.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. Kardos whose telephone number is (571) 270-3443. The examiner can normally be reached on Monday through Friday from 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neil R. Kardos
Examiner
Art Unit 3623

NRK
1/28/08

/Beth Van Doren/
Primary Examiner, Art Unit 3623